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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/566,342	01/27/2006	Robert Jason Herr	X16292	1828		
70512	7590	09/22/2008	EXAMINER			
Emisphere Technologies, Inc 240 Cedar Knolls Road Suite # 200 Cedar Knolls, NJ 07927				BIANCHI, KRISTIN A		
ART UNIT		PAPER NUMBER				
1626						
MAIL DATE		DELIVERY MODE				
09/22/2008		PAPER				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/566,342	HERR ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	KRISTIN BIANCHI	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 January 2008.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 7-9, 12 and 13 is/are allowed.
- 6) Claim(s) 1-5, 10 and 11 is/are rejected.
- 7) Claim(s) 6 and 14-17 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/27/2006</u> .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

Claims 1-17 are pending in the instant application. Claims 1-5, 10 and 11 are rejected. Claims 6 and 14-17 are objected. Claims 7-9, 12 and 13 appear to be allowable.

### ***Information Disclosure Statement***

Applicant's information disclosure statement filed on January 27, 2006 has been considered and a signed copy of 1449 is submitted herewith.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hinegardner et al.

Hinegardner et al. discloses the compound 2-p-Methoxyphenylthiazole-4- $\beta$ -propiionic acid (compound VII, Table I, page 4140) which anticipates a compound of the instant claims wherein one of R1 or R2 is C1-C6 alkoxy and the remaining variable (i.e. R1 or R2) is H, X is 1,3-thiazole, n is 2, and R3 is H.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2 and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by Dai et al. (*Bioorganic and Medicinal Chemistry Letters* 13 (2003) 3817-3820).

Dai et al. discloses compounds 5, 8, 11 (page 3818), and 21 (page 3820) which anticipate compounds of the instant claims wherein R1 and R2 are H, X is 1,3-thiazole or 1,3-oxazole, n is 5 or 6, and R3 is C1-C6 alkyl.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 4, 5, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dai et al. (*Bioorganic and Medicinal Chemistry Letters* 13 (2003) 3817-3820).

*Determining the scope and contents of the prior art.*  
Dai et al. discloses compounds 5, 8, 11 (page 3818), and 21 (page 3820).

*Ascertaining the differences between the prior art and the instant claims.*  
The compounds disclosed in Dai et al. are different from the compounds of the instant claims (i.e. claims 3, 5 and 11) because R3 of the instant claims is H whereas it is methyl in Dai et al.

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Compound 11 disclosed in Dai et al. contains a 1,3-thiazole whereas the formula of claim 4 in the instant claims contains a 1,3-oxazole.

*Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.*

To those skilled in the chemical art, one homologue is not an advance over an adjacent member of a homologous series. The reason for this is that one of ordinary skill, knowing the properties of one member of the series, would know what properties to expect in adjacent members. In re Henze, 85 USPQ 261 (1950). In re Wood, 199 USPQ 137 (C.C.P.A. 1978) and In re Lohr, 137 USPQ 548, 549 (C.C.P.A. 1963). Therefore, hydrogen and methyl are deemed obvious variants of each other. In regards to the 1,3-thiazole versus the 1,3-oxazole, oxygen and sulfur are also deemed obvious variants of each other because oxygen and sulfur are located in the same column of the periodic table so they are also expected to have similar properties or result in compounds with similar properties.

One of ordinary skill would be motivated to make the modifications required to arrive at the instant invention with reasonable expectation of success for obtaining a compound with the same activity.

Thus, the instant claims are prima facie obvious over the teaching of the prior art.

***Claim Objections***

Claims 6 and 14-17 are objected to for depending on a rejected base claim.

***Allowable Subject Matter***

Claims 7-9, 12 and 13 appear to be allowable over the prior art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIN BIANCHI whose telephone number is (571)270-5232. The examiner can normally be reached on Mon-Fri 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed, Ph.D./  
Primary Examiner, Art Unit 1626

Kristin Bianchi  
Examiner  
Art Unit 1626

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